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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,870	04/17/2001	Claude Jarkae Jensen	10209.166	5882
21999	7590	05/06/2004	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/836,870	JENSEN ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 5, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2, 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed on January 5, 2004. Claims 1, 2, 4-28 are pending. Claim rejection made under 35 U.S.C. § 112, first and second paragraphs are withdrawn in view of the claim amendment. Claim rejection made under 35 U.S.C. § 103 are withdrawn in view of the claim amendment. New rejections are made.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (JP 200095663A, machine translation) in view of Talon et al. (Derwent Acc. No. 2000-248448), Moniz (US 5,288,491) and Duffy et al. (US 5472699).

Kondo teaches cosmetic composition comprising plant extracts which provide skin whitening, oxygen scavenging and/or antimicrobial effect. *Morinda Citrifolia* (noni) is among the plant extracts disclosed in the reference. See translation, paragraphs [0001- -0009]. Kondo further teaches the invention may be formulated into various types of cosmetic compositions, including skin care lotion and face toilet, which is considered as a skin toner product. See translation, paragraph [0017]. The whitening effect of Mulberry bark extract (which is deemed to be noni) is also discussed in paragraphs [0025-36] and Table 2. The reference further teaches that the cosmetic compositions may include the additives that meet instant claims 19-26. The reference teaches also using astringent. See paragraph [0020]. These ingredients meet the “a

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balancing toner ingredient” and “a hydrating toner ingredient” limitation in instant claim 1.

While the cosmetic formulation in Kondo contains 4.8 % of *Morinda Citrifolia* (noni), differences in concentration in general will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Kondo, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Increasing the concentration of noni would be desirable to enhance the whitening, antioxidant, and antibacterial effect of the composition.

Kondo fails to teach “processed *Morinda Citrifolia* fruit juice”. The example composition in Kondo contains the bark extract of noni, examiner takes the position it would have been obvious to a skilled artisan that other parts of the same plant would inherently provide the same effects.

Talon teaches that it is well known to make processed noni fruit juice. The reference also teaches that the juice has antiseptic properties among others.

Moniz further teaches the topical use of poultice made with noni, which is a moisture mess, is well known for its medicinal effects. See col. 1, lines 56 – 66. Examiner takes the position that the recited “release of xeronine” in claims 1 and 2 necessarily takes place in the topical application of noni fruit juice or the in the juice itself.

Duffy teaches an aqueous cosmetic composition comprising botanical astringent comprising extracts from Witch Hazel, Linden which is a source of vitamin C, E, and farnesol, and St. John's Wort which is a source of vitamin A. Employing silica, water, ethyl alcohol (denatured alcohol), glycerin (a humectant), pyridoxine HCL, fragrances, thickeners, preservatives, and colorants are also disclosed. See col. 4, line 36 – col. 6, line 34. The reference teaches that the invention helps reduce the size of pore of the skin and control sebum secretion. See col. 2, lines 18 – 52.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the Kondo by adding processed noni fruit juice as motivated by Talon and Moniz because 1) Kondo teaches of using noni extract in cosmetic composition for whitening and antibacterial effects; 2) Talon teaches of the antiseptic effects of processed noni fruit juice; and Moniz teaches of topical use of noni. The skilled artisan would have been further motivated to look to prior arts such as Duffy for specific additive components suitable for botanical astringents and modified the composition of Kondo by incorporating such additives because of the expectation of successfully producing a skin care composition that improves skin appearance by whitening the skin, reducing the pore size and controlling oil secretion, and/or provides antiseptic effect. The method of topically applying the said composition to hydrate and balance pH of the skin would have been an obvious use of the combined toner composition comprising an astringent and humectant.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4-28 have been considered but are moot in view of the new ground(s) of rejection in part and unpersuasive in part.

Applicants' arguments regarding the rejections made under 35 U.S.C. § 112, first and second paragraphs are moot in view of the withdrawal of the rejection.

In response to applicants' arguments that "one of ordinary skill in the art would recognize that different ingredients often perform different functions or have different effects" is unpersuasive and lacks factual supports. Examiner respectfully notes that, in the contrary to applicants' argument, it is well known in pharmaceutical art the extracts derived from the fruits, the leaves, the bark or the roots of *Morinda citrifolia* have been used in treatment of tinnitus. See Gildund (US 2001/0033871 A1), abstract. Examiner views that the Gildund reference suggests that extracts from different parts of the plant can be indistinguishably used.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, while applicants assert that the references are "complete within themselves", the argument is an attack against individual references. The obviousness of modifying the Kondo composition as proposed by the examiner must be construed in view of the collective teachings of the all cited references.

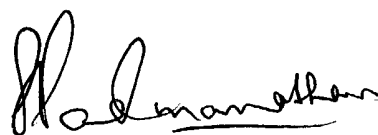
Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Gina C. Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER